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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/663,039

09/15/2003

Isaak Volynsky

MAT 3H2

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EXAMINER

HYLINSKI, ALYSSA MARIE

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

11/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,039

Applicant(s)

VOLYNSKY, ISAAK

Examiner

Alyssa M. Hylinski

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl (3284947). Dahl discloses a high-volume insert for use in molded toy figures having a hollow body portion configured to form an inner supporting structure for an appendage of a toy figure that can also maintain a hollow space within the appendage and wherein the insert has an engagement portion formed by an outer surface of the body to allow for it to engage with other portions of the toy figure by means of the outer skin covering (column 12 lines 43-53). The insert is useable within toy figures having a torso and limbs made of a least one soft flesh-like outer layer molded over the inner skeleton which includes the insert (Fig. 1). The reference discloses the basic inventive concept, substantially as claimed with the exception of the inner supporting structure or hollow insert occupying at least 50-70 percent of the volume of an associated portion of the appendage and the maximum diameter of the insert extending at least 70-75 percent across a diameter of the associated portion of the appendage. The examiner notes that it has been held that where the only difference between the prior art and the claimed device is a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the

prior art then the claimed device is not patentably distinct from the prior art.

Furthermore, changes in size are generally recognized as being within the level of ordinary skill in the art and as such a modification on the size of the insert would be entirely obvious. See *in re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

3. Claims 1-6 and 8-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piotrovsky (4470784), Lindsay (3350812) and Hales (2129421). Piotrovsky discloses a hollow body portion due to its having a cavity or space therein (Fig. 2) that will form the inner supporting structure of an appendage for a toy figure (Fig. 3) with at least one engagement portion having a first engagement portion in the form of a cylindrical boss (36) for pivotably connecting the insert to another portion of the toy figure such as the torso (Fig. 1) and a second engagement portion formed by a tab (34) that engages the limb portion of the toy (Fig. 2). The boss is attached to the tab (34), which has a convex surface for supporting the boss and a reinforcement ridge for supporting the engagement portion (Fig. 2). The insert is also equipped with a plurality of pins and pegs (56, 46) for stabilizing the insert within a mold so as to injection mold the toy figure (Fig. 8). The insert is shaped to partially conform to an outer surface of the appendage (Fig. 8). The tab and boss each have a substantially semicircular edge that is configured to rotate smoothly within an outer covering of the toy figure (Fig. 2, column 2 lines 58-63). The hollow body insert is meant for use within a toy figure having a torso and limbs (Fig. 1) made of a soft flesh-like outer layer molded over the

insert (column 2 lines 58-63). Piotrovsky discloses the basic inventive concept, with the exception of the body portion being configured to maintain a hollow space. Lindsay discloses an insert member (Figs. 1 & 2) having a first enclosed tubular body segment and a second upper body segment (32) with a substantially hollow region formed between the two segments (Fig. 4). The first body segment includes a cylindrical dowel (22 b,c) while the second body segment includes a hollow boss for helping to slidably receive the dowel so as to join the segments (Figs. 3-5). Although the reference does not disclose the dowel being hollow or the boss being cylindrical the examiner notes that such limitations would have been an obvious matter of design choice to a person of ordinary skill in the art since Applicant has not disclosed that making the dowel hollow or the boss cylindrical provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the connections as disclosed by the references since an internal insert for a toy doll was still created. It would also have been obvious to one of ordinary skill in the art to have a portion of the insert be an enclosed tubular member with a boss element having a hollow since such a modification would have involved a mere change in the shape of the insert. Changes in shape are generally held to be within the level of ordinary skill in the art. *See in re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Piotrovsky and Lindsay disclose the basic inventive concept, with the exception of the tubular member being hollow. Hales discloses an internal insert for a toy doll consisting of hollow tubular members (Fig. 9). It would have been obvious to make the tubular member of Piotrovsky and Lindsay

hollow since Hales shows that hollow insert members would be an art recognized equivalent and as such it would have been obvious to substitute a hollow tube for the tube as shown by Lindsay. The references disclose the basic inventive concept, substantially as claimed with the exception of the inner supporting structure or hollow insert occupying at least 50-70 percent of the volume of an associated portion of the appendage and the maximum diameter of the insert extending at least 70-75 percent across a diameter of the associated portion of the appendage. The examiner notes that it has been held that where the only difference between the prior art and the claimed device is a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art then the claimed device is not patentably distinct from the prior art. Furthermore, changes in size are generally recognized as being within the level of ordinary skill in the art and as such a modification on the size of the insert would be entirely obvious. See *in re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

4. Claims 7, 31-34 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piotrovsky Lindsay, Hales and Weis (2174932). Piotrovsky, Lindsay and Hales disclose the basic inventive concept, substantially as claimed, with the exception of the body portion being frustoconical in shape. Weis discloses an internal support structure for a figure or manikin that is covered in a soft, flesh-like outer covering (column 2 lines 3-17) including a hollow frustoconical shaped insert (54)

positioned therein (Figs. 1, 9 & 10). The references disclose a cylindrical insert as opposed to a frustoconical shaped insert but, Weis discloses that the use of hollow frustoconical shaped inserts in molded figures would be an art-recognized equivalent at the time of invention. Therefore, one of ordinary skill in the art would have found it obvious to substitute the cylindrical insert for the frustoconical shaped insert of Weis. Furthermore, changes in shape are generally held to be within the level of ordinary skill in the art. *See in re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Response to Arguments

5. Applicant's arguments with respect to claim 1-34 and 36-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH


EUGENE KIM
SUPERVISORY PATENT EXAMINER